

Appln No. 09/886,538
Amdt date December 7, 2005
Reply to Office action of July 7, 2005

REMARKS/ARGUMENTS

This Response is filed with a Request for Continued Examination (RCE) in compliance with 37 CFR §1.114. Claims 3-16 are pending in this application. In the Office Action mailed July 7, 2005, claims 3-16 were rejected under 35 USC §103(a) as being allegedly unpatentable over Celik (U.S. Patent No. 6,374,259), in view of Delany et al. (U.S. Patent No. 6,658,454), and further in view of Cotten (U.S. Patent No. 6,330,590). Applicant thanks the Examiner for attending to the application.

Claim 3

Claim 3 specifies a method using a computer of updating personal information comprising, in part, providing contact information regarding a user to at least some of the contacts of the user on a distribution list of contacts of the user.

The Office Action appears to indicate that Cotten discloses, "providing the contact information to at least some of the contacts of the user on the distribution list" at Cotton, col. 1, lines 11-23. More particularly the Office Action appears to point to the statement that "Bulk e-mail companies thus tend to build and release mailing lists of e-mail addresses and use those lists to send messages with little discrimination or protection of the recipient's rights, desires or needs." (Cotten, col. 1, lines 11-23).

There appears to be no indication in Cotton that the release or use of lists of e-mail addresses by bulk e-mail companies discloses or necessarily results in "providing the contact information to at least some of the contacts of the user on the distribution list", as specified in claim 3. Claim 3 is therefore allowable. Claims 4-14, dependent on claim 3, are also therefore allowable.

Moreover, the Office action appears to conclude from the cited portion of Cotten that "Cotten implies that it is known in the art that certain companies collect and distribute or release users' personal information to another party such as a marketing company or another user." (Office Action, p. 5, lines 2-4). Such a conclusion, however, would appear to result in Cotten

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teaching away from the invention as claimed in claim 3, as, for example, such distribution appears not to require, use, or desire a distribution list of contacts of the user, also as specified in claim 3.

Accordingly, it appears inappropriate to use Cotten in combination with other references to arrive at the invention as claimed in claim 3. Accordingly, claim 3 and dependent claims 4-14 are further allowable.

Further, it appears that the Office Action improperly uses hindsight to pick and choose among disclosures to reach its conclusions. (*See, e.g., In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.")).

Therefore, claim 3 is believed to be allowable. Since claims 4-14 depend, directly or indirectly, from claim 3 and contain additional limitations that are patentably distinguishable over the reference of record, claims 4-14 are also believed to be allowable.

Claim 15

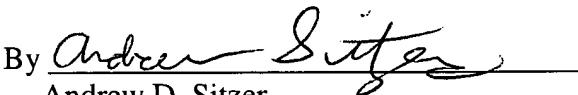
Claim 15 was rejected on the same basis as claim 3. (See Office action, p. 2-5). Claim 15 is an apparatus claim, claim 3 is a method claim. Claim 15 is not identical to claim 3, and it is believed that claim 15 has been improperly rejected and that the cited references do not teach or suggest the invention as claimed in claim 15.

Claim 15 specifies "wherein the server is configured to provide contact information of a specific user to at least some individuals indicated in contact list information for the specific user when the contact information for the specific user changes." In view of the discussion relating to claim 3 it is not believed the art of record discloses or suggests "wherein the server is configured to provide contact information of a specific user to at least some individuals indicated in contact list information for the specific user when the contact information for the specific user changes". Accordingly, claim 15 and its dependent claim 16 are allowable.

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In view of the foregoing remarks, Applicant respectfully requests reconsideration of the application and allowance of claims 3-16.

Respectfully submitted,
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